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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,244	12/31/2003	Min-Seok Choi	P24738	6998

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EXAMINER

STORMER, RUSSELL D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,244	Applicant(s) CHOI, MIN-SEOK	
	Examiner Russell D. Stormer	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. '11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

There is no description of the mount "provided in" the outermost end of the trailing arms as set forth in claims 1, 5 and 8.

Lines 13 and 14 of page 5 of the instant specification state that the trailing arm is provided with a mount 4a on which a shock absorber is mounted.

Line 15 states that the mount 4a is "formed" by cutting off an end of the trailing arm; there is no suggestion that the mount is provided "in" the trailing arm.

Lines 18 and 19 state that the cut-off section (which formed the mount) is formed "on" the end of the trailing arm, or "on" an upper portion of the trailing arm, or "on" upper and lower portions of the trailing arm.

Lines 4 and 5 of page 6 further emphasizes that the shock absorber 20 is mounted to the trailing arm 4 by means of "the mount 4a formed on the trailing arm 4."

The lead line for the reference character 4a as shown in figure 2 points to a location on an outer surface near the end of the trailing arm 4.

Therefore, it is clear that the mount 4a is described as being formed on the trailing arm, and the specification provides no support or suggestion that the mount 4a can be provided "in" the trailing arm as set forth in claims 1, 5, and 8.

See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

2. The disclosure is objected to because of the following informalities:

On page 5, the first half of the sentence bridging lines 21-23 appears to contradict the second half, and the word "meanwhile" appears to be incorrectly used in the sentence.

In line 2 of page 7, the term "matters" should be changed to - -matter- -.

In line 5 of page 7, the phrase "reduce a friction accused by" does not make sense.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 sets forth a "mount provided in" a trailing arm that mounts a shock absorber.

Claim 4, which depends from claim 1, claims the trailing arms as including a "portion configured as a mount that receives the shock absorber."

Claim 4 is vague and indefinite and conflicts with claim 1 because it is not clear in claim 4 if the mount is "in" the trailing arm or if the trailing arm has a portion configured as a mount, or if claim 4 is claiming a second mount.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 5, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Glaser et al (U.S. Patent Number 6152468; newly cited).

Glaser et al '468 discloses a torsion beam axle suspension comprising left and right trailing arms 3, a torsion beam 2 coupled to the trailing arms, and a shock absorber mount provided in the outermost end 4 of the trailing arms. An opening 32 is formed in the eye 31 which is on the end 4 of the trailing arm and the opening receives the mount for the shock absorber. The mount would inherently include a member such as a fastener or pin extending through the opening, and is therefore considered to be "provided in" the outermost end of the trailing arm.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glaser et al '468 in view of MacIsaac.

Glaser et al '468 meets all of the limitations of claims 1, 5, and 8 as set forth in paragraph 2 above, but the shock absorber is not shown.

MacIsaac (previously cited) teaches a suspension assembly including a shock absorber. In figures 10 and 11 the connection between the axle and the shock absorber is in the form of a ball joint 250, including a ball stud and a socket. From this teaching it would have been obvious to provide the trailing arm suspension of Glaser et al '468 with a shock absorber having a ball and socket joint as this would allow a wide range of movement (such as movement in more than one plane) between the shock absorber and the axle.

10. Claims 3, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glaser '468 in view of MacIsaac as applied to claims 2, 6, and 9 above, and further in view of Molenaar.

It is clear that the ball joint 250 of MacIsaac would include a socket and a ball stud, but details of the ball and socket joint are not shown.

Molenaar teaches a ball and socket joint comprising a socket 3 bored with at least one hole to receive a fastener 20, and a ball stud 21 fitted in the socket. From this teaching it would have been obvious for the ball joint of Glaser et al '468 as modified by MacIsaac to comprise a ball stud fitted in a socket for pivotal movement, and the socket having at least one bore for receiving a fastener so that the socket could be fastened to the axle assembly.

Response to Arguments

11. Applicant's arguments with respect to claims 1, 5, and 8 are have been considered but are moot in view of the new grounds of rejection.

Glaser et al '468 is considered to meet the language of claims 1, 5, and 8 because the fastener or pin which secures the shock absorber to the end of the trailing arm is fitted in the opening 32 and would inherently be at least partially "in" the end of the trailing arm. However, since Applicants' specification is unclear, and in fact silent, as to the definition of the term "in" as used in claims 1, 5, and 8, and as argued in the response filed July 31, 2006, the limitations of the term "in" as claimed are open to interpretation.

With respect to the arguments against the use of the MacIsaac and Molenaar references, sufficient reasoning and motivation for applying the teachings of MacIsaac and Molenaar to the rejection are clearly presented in paragraphs 5 and 6, respectively, of the previous office action, and paragraphs 9 and 10 of the instant office action.

Applicant's statement that the Examiner has not presented sufficient motivation is not well-taken and is clearly in error.

Applicant's characterization of MacIsaac as "purportedly" teaching a ball and socket, and of Molenaar "purportedly" teaching an insert hole which receives a fastener appears to be misguided inasmuch as MacIsaac actually does disclose a shock absorber having a ball and socket joint, and Molenaar actually does disclose a ball and socket joint which includes a hole and a fastener.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The argument that the use of Molenaar to further modify the teachings of the base reference and MacIsaac "appears to constitute an impermissible modification of a modification" is noted. However, the impermissibility of such a modification is in question. Applicant is requested to cite guidance in the MPEP to prove that such a rejection is indeed "impermissible."


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (571) 272-6687. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

10/10/06


RUSSELL D. STORMER
PRIMARY EXAMINER 10/10/06